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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,965	03/28/2001	Takao Yoshimine	275745US6	4221
22850 7590 09/07/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER CHAMPAGNE, DONALD	
			ART UNIT	PAPER NUMBER
			3622	
			NOTIFICATION DATE	DELIVERY MODE
			09/07/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/819,965

Applicant(s)

YOSHIMINE ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-43, 45-54, 56-65, 67-69 and 97 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 37-43, 45-54, 56-65, 67-69 and 97 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 28 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 July 2007 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 37-43, 45-54, 56-65, 67-69 and 97 are rejected under 35 U.S.C. 103(a) as being obvious over Logan et al. (US005721827A).
4. Logan et al. teaches (independent claims 37, 48, 59 and 97) an apparatus, method and computer readable storage medium for determining a *content provider royalty payments*, which reads on a share of profits (para. 6 below), the method comprising:

receiving from a content creator/*content provider* via internet (col. 2 line 64), content data (*programming*, col. 1 lines 39-47) and predetermined information including at least category information indicating genre of the content data (*subject category* and *program topic descriptions*, col. 1 lines 56-60 and col. 28 lines 29-31);

accessing the content data (*programming*) provided by received from the content creator, the content data including advertising data (*programming and advertising segments*, col. 6 lines 56-60);

transmitting, via a network (col. 4 line 13 and Fig 1) selected content data/*programming* to one or more user locations (players 103, col. 2 line 63 to col. 3 line 9), in response to a

request from the one or more user locations for the selected content data/*programming* (col. 6 lines 45-51);

calculating *royalties*, which reads on a share of profits (para. xx below), to be earned by the content creator as a function of the number of transmissions of the selected content data/*programming*, and whether the selected content included advertising data (col. 20 lines 3-20); and

storing and accumulating the *royalties*/share of profits to be paid to the content provider in a content provider information database (account number of the content creator, col. 17 lines 15-19, where the content creator is identified in a *Content Providers Table 315*, col. 16 lines 38-46).

5. Note on interpretation of claim terms - Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.
6. The instant application contains no such clear definition for any of its terms. In particular, "profit" is not given a "clear definition" in the specification, and indeed has no precise definition in accounting. Logan et al. teaches paying *royalties* to *content providers* (col. 6 lines 8-9). A "royalty" is defined as a profit share or other payment to an author or composer (Merriam-Webster's Collegiate® Dictionary, 10th ed.) Hence one of ordinary skill in the art would understand that *royalties* provided to *content providers* reads on the claimed "share of profits for the content creator".
7. "Content creator" is also not clearly defined in the spec. The spec. (para. [0087]-[0088] and Fig. 2 of the published application, US 20020046097A1) tries to distinguish between a "content provider" and "content creator", but no operational distinction is disclosed and the

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"content provider" is not claimed. As noted above, Logan et al. teaches (col. 6 lines 8-9) a mechanism for providing *royalties* to *content providers*. One of ordinary skill in the art of the advertising would readily understand that the *content provider* taught by Logan et al. is the claimed "content creator".

8. Logan et al. does not explicitly teach that the content data (*programming*) is received from a device of a content creator. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted, first, that the content data/*programming* must, by definition, originate, with a content creator. (The content data/*programming* cannot create itself.) Second, content data/*programming* is received into a electronic *program data library 130* (col. 4 lines 21-27 and Fig. 1), so it must necessarily be received by some electronic device. Said device reads on a device of a content creator.
9. Logan et al. does not teach that the category information indicating genre of the content data (*subject category* and *program topic descriptions*, col. 1 lines 56-60 and col. 28 lines 29-31) is appointed by the content creator. "Appointed" is interpreted to mean selected by the content creator (para. [0147] of the published application). Because the content creator knows the work best, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teaching of Logan et al. that the category information indicating genre of the content data (*subject category* and *program topic descriptions*) be appointed by the content creator.
10. No patentable weight was given to the content data including "advertising data affixed thereto, said advertising data being affixed based on commercial desired data generated in response to a selection by the content creator", because this limitation is nonfunctional descriptive material (MPEP § 2111.01). The US Patent & Trademark Office does recognize a distinction between "advertising" and other content when there is some functional basis. If, as in the instant case, the advertising is merely part of the content, then there is no patentable distinction.
11. Also, as was noted in the last Office action (para. 11 of the Office action mailed 9 April 2007), because anything promotional is "advertising" (e.g., the mere mention of a product or brand name is "advertising"), it is very common for content to have "advertising data affixed

thereto, said advertising data being affixed based on commercial desired data generated in response to a selection by the content creator" (i.e., chosen by the creator to make the work commercially valuable). Hence, even if the subject limitation were given patentable weight, it is very common and therefore obvious.

12. Logan et al. also teaches at the citations given above claims 38, 49 and 60; claims 40-41, 51-52 and 62-63, where *subscription cost* (col. 10 line 1) reads on connection fee and use fee; and claims 45, 56 and 67 inherently.
13. Logan et al. also teaches claims 39, 50 and 61 (col. 9 lines 5-11); claims 42, 53 and 64 (col. 9 lines 62-63); 43, 54 and 65 (col. 9 lines 5-11, where *defray subscription costs* reads on applying the credit to a purchase over the network); and claims 47, 58 and 69, where *royalty payments due to content providers* (col. 15 lines 40-41) reads on contributions.
14. Logan et al. does not teach (claims 46, 57 and 68) that the ad is placed at the head (beginning) of the content. Because it is common practice to begin programming with advertising, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to the teachings of Logan et al. that the ad is placed at the head (beginning) of the content.

Response to Arguments

15. Applicant's arguments filed with an amendment on 9 July 2007 have been fully considered but they are not persuasive. The arguments have been addressed by the revised rejection presented herein.

Conclusion

16. This is a continuation of applicant's earlier Application No. 09819965. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
17. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of

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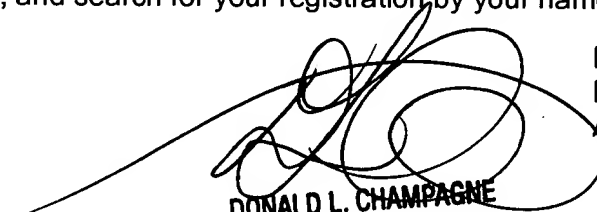
the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
19. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
21. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
22. Applicant may have after final arguments considered and amendments entered by filing an RCE.

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23. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

1 September 2007



DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
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